

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed March 29, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Initial Matters**

Applicants note that during the prosecution of this application, Applicants inadvertently introduced several errors into the claims listing. Each error has been corrected through this response, and each is addressed separately below.

#### **A. Claim 9**

The Office Action states that claim 9 is a substantial duplicate of claim 8. *Office Action*, pg. 2. Applicants note that through the Response filed July 12, 2004, the text of claim 9 as originally presented was inadvertently replaced with a duplicate copy of claim 8. Through this response, Applicant has amended this error. Claim 9 now incorporates the limitations presented in the claim as originally filed instead of duplicating claim 8.

#### **B. Claim 11**

It appears Applicants presented two distinct claims identified as claim 11. The application as filed on January 19, 2001 presented the following claim 11 ("the first claim 11"):

11. A method of managing network servers comprising: updating a database with new configuration parameters for a network server computer; and automatically triggering a daemon running on said network server computer in response to said database update, wherein said daemon is configured to retrieve said new configuration parameters and to configured an application program in accordance therewith.

The first claim 11 was withdrawn through the Response filed July 12, 2004. To the extent that the first claim 11 does not stand canceled, Applicants cancel the first claim 11 through this

response without prejudice, waiver, or disclaimer. Applicants reserve the right to present the canceled claim, or variants of the canceled claim, in subsequently filed continuing applications.

The Response filed on November 18, 2004 presented the following claim 11 ("the second claim 11"):

11. The method of claim 7, wherein the server is operated by a web-hosting provider.

The second claim 11 was canceled through the response filed October 24, 2005. To clarify the record and minimize the issues, Applicants state that all claims presented as "claim 11" now stand canceled, to Applicants' knowledge.

## **II. Specification Objection**

The specification has been objected to for containing various informalities. Specifically, the Office Action identifies that the "co-pending application status needs to be updated... [with a] specific reference to the parent either (1) on an application data sheet [or] (2) in the first paragraph of the specification." *Office Action*, pg. 4. In response to the objection, Applicants amend the specification to provide the omitted cross-reference, as well as to correct typographical errors introduced into the "Cross Reference to Related Applications" section by amendment filed November 18, 2004. Although these amendments effect various changes to the specification, Applicants assert that no new matter has been added and that the specification is not objectionable. Therefore, Applicants respectfully ask the Examiner to withdraw the objection.

### **III. Priority**

The Office Action states that "the effective filing date for the subject matter defined in the pending claims in this application is 01/19/2001." *Office Action*, pg. 4. In response, Applicants amend the specification to include a cross-reference to the application of which the present application is a continuation. Further, Applicants notes that a Petition to Accept an Unintentionally Delayed Priority Claim under 37 C.F.R. 1.78(a)(3) has been filed concurrently with this Response, along with the required fee. Therefore, Applicants respectfully assert that the effective filing date for the subject matter recited in the pending claims is May 5, 2000 and not January 19, 2001.

### **IV. Double Patenting Rejections - Obviousness-type Double Patenting**

Claims 8-9 and 12-27 have been rejected under the doctrine of obviousness-type double patenting as being unpatentable in view of claims 1-22 of U.S. Patent No. 6,842,769 ("the '769 patent"). Although Applicants do not concede the rejection is proper, Applicants have submitted a terminal disclaimer with this response in the interest of expediting issuance of a patent from the present application. The terminal disclaimer disclaims any portion of term for a patent issuing from the present application that will extend beyond the term of the '769 patent. Therefore, Applicants respectfully ask the Examiner to withdraw the rejection.

### **V. Claim Objections**

Claim 25 has been objected to under 37 C.F.R. § 1.75(c) for failing to refer back to and further limit another claim. Specifically, the Examiner notes that claim 25 does not refer to another claim. *Office Action*, pg. 6. In response to the objection, Applicants amend claim 25 so that the claim now depends from claim 24. In view of this amendment, Applicants respectfully submit that claim 25 is not objectionable and respectfully ask the Examiner to withdraw the objection.

## **VI. Claim Rejections - 35 U.S.C. § 102**

Claims 24 and 26 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,785,706 to *Horman* ("*Horman*"). Applicants respectfully traverse these rejections. A rejection of a claim under 35 U.S.C. § 102(e) is only proper if (1) the applied reference constitutes prior art under § 102(e) and (2) the applied reference anticipates the rejected claim. See 35 U.S.C. § 102(e). In the present case, *Horman* does not constitute § 102(e) prior art and *Horman* does not anticipate the rejected claims, as described below.

### **A. *Horman* does not constitute prior art under 35 U.S.C. § 102(e)**

*Horman* does not constitute prior art under 35 U.S.C. § 102(e). Therefore, the rejections are improper and should be withdrawn. 35 U.S.C. § 102(e) provides as follows:

A person shall be entitled to a patent unless...

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language...

In other words, for a reference to constitute prior art under 35 U.S.C. § 102(e), the reference must be either an issued U.S. patent or a publication of a U.S. or PCT application. *MPEP* § 706.02(f)(1)(I)(A). In the case of a U.S. patent or publication, the earliest effective U.S. filing date of the reference must precede the earliest effective U.S. filing date of the application having the rejected claim. 35 U.S.C. § 102(e); *MPEP* § 706.02(f)(1)(I)(B). The earliest effective U.S. filing date is affected by a claim of priority under 35 U.S.C. §§ 119(e) or 120. *Id.* However, a claim of priority to a foreign application filing date under 35 U.S.C. §§ 119(a)-(d), (f) or 35 U.S.C. § 365(a or b) does not establish an effective U.S. filing date for prior art purposes under 102(e). *MPEP* § 706.02(f)(1)(I)(D). Additional rules and exceptions apply is the

reference is a publication of a PCT application, or if a PCT application appears in the continuity chain. *MPEP* § 706.02(f)(1)(I)(B-C).

In the present case, *Horman* is not prior art under 35 U.S.C. § 102(e) because the effective U.S. filing date for the Applicants' application precedes the earliest effective U.S. filing date for *Horman*. More specifically, *Horman* issued from an application filed in the U.S. on August 31, 2000. *Horman* includes a foreign priority claim to Canadian Patent No. 2,281,367 filed Sept. 1, 1999, but for the purposes of 35 U.S.C. § 102(e), the Canadian patent is irrelevant. *MPEP* § 706.02(f)(1)(I)(D). Therefore, the earliest effective U.S. filing date for *Horman* is August 31, 2000. Applicants' application was filed on January 19, 2001. However, Applicant has amended the Application through this response to clarify the Application is a continuation of U.S. Ser. No. 09/565,270 filed May, 5, 2000. Further, Applicants have submitted a Petition under 37 C.F.R. § 1.78(a)(3) to claim the benefit of the earlier filing date under 35 U.S.C. § 120, along with the appropriate fee and a statement that the delay was unintentional. Because Applicants properly claim the benefit of an earlier filed application under 35 U.S.C. § 120, the earliest effective U.S. filing date for Applicants' application is May 5, 2000. *MPEP* § 706.02(f)(1)(I)(B).

Because Applicants' application has an effective U.S. filing date of May 5, 2000 and *Horman* has an effective U.S. filing date of August 31, 2000, *Horman* does not constitute prior art under 35 U.S.C. § 102(e). Therefore, Applicants respectfully ask the Examiner to withdraw the rejections.

**B. *Horman* does not anticipate Applicants' claims**

In addition to not constituting prior art, *Horman* does not anticipate Applicants' claims. "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220

U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, for a rejection of a claim to be proper under 35 U.S.C. § 102, the cited reference must disclose each element of the rejected claim. In the present case, *Horman* does not disclose each element of Applicants' claims. Specifically, Applicants' claim 24 provides as follows (emphasis added):

A method of synchronizing configuration parameters on a server with a database of stored configuration parameters comprising automatically updating at least one application program configuration parameter in response to updating at least one corresponding stored application configuration parameter in said database, ***wherein each application program configuration parameter defines at least in part a set of resources on the server available to a particular user of the server.***

Applicants' claim 26 provides as follows (emphasis added):

An information processing system comprising:  
at least one network server running at least one application program, wherein application program operation is defined at least in part by a set of configuration parameters stored on said at least one network server and associated with said application program operation;  
a database separate from said at least one network server and storing a copy of said set of configuration parameters; and  
means for automatically maintaining synchronization between said set of configuration parameters stored on said at least one network server and said copy of said set of configuration parameters stored in said database, ***wherein each application program configuration parameter defines at least in part a set of resources on the network server that are made available to a particular user of the network server.***

*Horman* does not disclose "each application program configuration program parameter defines at least in part a set of resources on the server available to a particular user of the server." The Office Action finds this limitation in the following passage of

Although this high-level description of state-transition actions is necessary for simplified management, the general description of actions is translated into specific actions for each member of the group in order to actually affect the desired change. The PST is, as its name indicates, a Script Template. It is a template of the actual script that a given member of the group (a database server) will execute. The script template is instantiated into an actual script that a database server executes by replacing embedded parameters with values specific to the database server. That is, the parameters in a PST represent the attributes or characteristics that are unique to each member of the group.

Office Action, pg. 7; *Horman*, col. 2, lines 50-61. The Office Action also finds this limitation in the following passage of *Horman*:

The actual script that a group member must execute to effect the change of state is an instantiation of the PST wherein all parameter markers are replaced by corresponding values that particular group member's characteristics.

Referring to FIG. 1 which illustrates the instantiation of a PST, the important elements of this depiction are: the single command (1) in the simple PST (2), in which a single parameter marker{{userid}} (6) is embedded, the table (3) of unique characteristics of each group member; and the production of an actual script (4) for member 123 through the process of instantiation (5). The parameter marker, {{userid}} (6) in this example, identifies the desired attribute, userid (7). The process of instantiation replaces all such parameter markers within the script template with the corresponding values of the attributes for the group member. In this case, the parameter marker{{userid}} (6) is replaced with the value JSMITH (8). Group member 123 would then execute the instantiated script to effect the change of state embodied in the PST. Each input to the instantiation process will now be described in greater detail.

*Office Action*, pg. 7; *Horman*, col. 3, ln 17-36. It is not clear how the above description discloses an "application program configuration parameter" that "defines at least in part a set of resources on the server available to a particular user of the server." For at least these reasons, Applicants' claims 24 and 26 are not anticipated and Applicants respectfully ask the Examiner to withdraw the rejections.

## **VII. Claim Rejections - 35 U.S.C. § 103(a)**

Claims 8-9, 12-23, 25, and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Horman* in view of U.S. Pat. No. 6,560,639 to *Dan, et al.* ("*Dan*"). Applicants respectfully traverse these rejections. A rejection under § 103(a) is only proper if (1) the applied references constitute prior art under 35 U.S.C. § 102, and (2) the U.S. Patent and Trademark Office ("USPTO") carries the burden of establishing that the claim would be prima facie obvious to a person of ordinary skill in the art. See 35 U.S.C. § 103(a); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). In the present case, the rejections should be withdrawn because *Horman* does not constitute prior art, and the USPTO has not proven the claims are prima facie obvious, as described below.

**A. *Horman* does not constitute prior art under 35 U.S.C. § 102(e)**

As mentioned above, Applicants' application has an effective U.S. filing date of May 5, 2000, which predates the August 31, 2000 effective U.S. filing date of *Horman*. Therefore, *Horman* does not constitute prior art under 35 U.S.C. § 102(e), and Applicants respectfully ask the Examiner to withdraw the rejections.

**B. Applicant's claims are not obvious**

Applicants' claims are not obvious based on *Horman* in view of *Dan*. For a claim to be *prima facie* obvious, the following requirements must be satisfied. First, the reference or combination of references must teach or suggest each element of the rejected claim. *MPEP* § 2143. Second, a suggestion or motivation to modify or to combine the cited references must be found in the prior art or the knowledge of a person of ordinary skill in the art, and not in Applicant's disclosure. *Id.* Third, the combination or modification must be such that a person of skill in the art would reasonably expect the combination or modification to be a success. *Id.* In the present case, a *prima facie* case of obviousness has not been established against Applicant's claim, as described below.

**1. Claims 12 and 18**

Applicants respectfully submit that claims 12 and 18 are allowable for at least the reason that the proposed combination of *Horman* in view of *Dan* does not disclose, teach, or suggest at least the feature of "wherein each application program configuration parameter defines at least in part a set of resources on the server available to a particular customer of a web hosting provider" as recited in claims 12 and 18.



**(i) The *Horman* Reference**

*Horman* describes a method for synchronizing the configuration of each server in a group of administered servers to match the configuration of a control server. Synchronization in *Horman* is achieved by running parameterized scripts on each administered server. The Office Action has not clearly explained what element in *Horman* is alleged to correspond to the claimed “application configuration parameters.” Applicants will assume, *arguendo*, that the script parameters correspond to “application configuration parameters that define at least in part a set of resources on the server.” Even so, *Horman* contains no discussion at all of how the script parameters relate to server resources “available to a particular customer of a web hosting provider.” Thus, *Horman* does not disclose, teach, or suggest the above-described feature recited in claims 12 and 18.

**(ii) The *Dan* Reference**

The Office Action alleges that FIG. 2 and Col. 14, lines 38-43 of *Dan* disclose the feature “wherein each application program configuration parameter defines at least in part a set of resources on the server available to a particular customer of a web hosting provider.” *Office Action*, pg. 4-5. Applicants respectfully disagree.

First, FIG. 2 is a system level diagram showing various components of the web management system 30. Neither FIG. 2 nor the corresponding text disclose “an application program configuration parameter.” Next, the passage at Col. 14, lines 38-43 of *Dan* discusses an Asset Manager component 60 of the web management system 30, where assets are “practically any type of binary file that, for example, contains its own description, such as graphical files, text files, video images, and audio files.” *Dan*, col. 13, ln. 40-45. The Asset Manager 60 “allow[s] the user to find, upload, and/or organize these files any way the user wants.” *Dan*, col. 13, ln. 40-45. The cited passage then describes how a user updates an

asset with a new image. Applicants will assume, *arguendo*, that these assets correspond to the claimed “set of resources on the server.” Even so, the assets in *Dan* have nothing to do with application configuration parameters.

Applicants also note that the only sentence in the cited passage that contains any words at all recited in the above-described feature is the following: “Advantageously, an asset, which in the above example is *available* to everyone on the user’s web management team at all times.” *Dan* teaches “available to everyone” while claims 12 and 18 recite “available to a particular customer of a web hosting provider.”

### **(iii) The Combination of *Horman* and *Dan***

Applicants respectfully assert that the assets in *Dan* cannot be meaningfully combined with the script parameters in *Horman*. Thus, the combination of *Horman* and *Dan* does not disclose, teach, or suggest disclose the feature “wherein each application program configuration parameter defines at least in part a set of resources on the server available to a particular customer of a web hosting provider.” Since the proposed combination does not teach at least the above-described features recited in claims 12 and 18, a *prima facie* case establishing an obviousness rejection has not been made. Thus, claims 12 and 18 are not obvious and the rejection should be withdrawn.

## **2. Claims 8-9, 11, 13-17, 19-23, 25, 27**

Because claims 12 and 18 are allowable, Applicants respectfully submit that claims 8-9, 11, 13-17, 19-23, 25, and 27 are allowable for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 8-9, 11, 13-17, 19-23, 25, and 27 be withdrawn.

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#### **VIII. Canceled Claims**

Through this response, claim 11 has been canceled from the application without prejudice, waiver, or disclaimer. Applicants reserve the right to present the canceled claims, or variants of the canceled claims, in subsequently filed continuing applications.


#### **IX. New Claims**

Through this response, claims 28-32 have been added to the application. Applicants assert that the new claims are novel and are not obvious in view of the prior art of record. Therefore, Applicants respectfully ask the Examiner to allow these claims.

**CONCLUSION**

Applicant respectfully asks the Examiner to withdraw the outstanding objections and rejections, and to allow issuance of the application and pending claims. Further, Applicant invites the Examiner to call the Applicant's undersigned counsel at (770) 933-9500 if the Examiner believes a telephone conference would expedite the examination of this application.

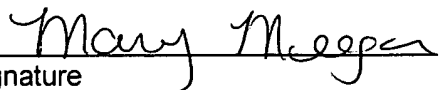
Respectfully submitted,

  
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